

## **REMARKS**

### **Introduction**

Claims 1 – 7 were originally pending in the present application. Claims 8 - 10 were previously added, claims 1 and 4 – 7 were previously amended, and claims 4 and 6 – 10 were previously cancelled. Claim 1 has been amended herein. No new matter has been added. Accordingly, claims 1 – 3 and 5 are presently pending for consideration in this application.

### **Claim Rejections**

#### **35 U.S.C. § 103**

Claims 1 – 3 and 5 have been rejected under 35 U.S.C. § 103(a) as being obvious over the Pratelli '157 application in view of the Hynes '880 patent. More specifically, the Examiner states that it would have been obvious to one of ordinary skill in the related art at the time the invention was made to attach double sleeves and a second frame portion of the Hynes device to structure of the Pratelli device in order to close a frame of the Pratelli device so that a storage pouch thereof cannot slip off and allow the frame to expand to support flexible bags of different sizes. Claim 1 has been amended herein. Support for the amendments can be found in Figure 1 and page 2 (lines 17 – 18), page 3 (lines 3 and 12 -13), and page 4 (lines 9 – 10) of the present application. The applicant cannot agree that the invention defined in amended claim 1 is obvious over the Pratelli '157 application in view of the Hynes '880 patent. Accordingly, these rejections are respectfully traversed.

Also, claims 1 – 3 and 5 have been rejected under 35 U.S.C. § 103(a) as being obvious over the Baker '344 patent in view of the Hynes '880 patent. More specifically, the Examiner states that it would have been obvious to one of ordinary skill in the related art at the time the invention was made to use a two-part frame with telescoping sleeves of the Hynes device with the Baker device in

order to allow the frame to support flexible bags of different sizes. As noted above, claim 1 has been amended herein. The applicant cannot agree that the invention defined in amended claim 1 is obvious over the Baker '344 patent in view of the Hynes '880 patent. Accordingly, these rejections are respectfully traversed.

### **The Prior Art**

#### **The Pratelli '157 Application**

The Pratelli '157 application discloses a collapsible/foldable bag holder 10 including a fixed hinge part 11 adapted to be mounted to a structure and a relatively movable hinge part 12. A pair of elongate arms 13 project from the movable hinge part 12 transversely of an axis defined by the fixed hinge part 11. The arms 13 are fitted with means 14 for securing upper extremities of a bag so as the arms 13 can hold a mouth of the bag in an open orientation when the bag is mounted on the arms 13. Locking means 18 restrain the movable hinge part 12 and arms 13 in a generally horizontal plane, whereby release of the locking means 18 enables the arms 13 to pivot about the axis for movement of the arms 13 into a non-use position such that the arms 13 fold downwardly under gravitational force and rest in a vertical orientation.

However, the Pratelli '157 application fails to disclose or suggest a trunk space storage system including a pair of hinges adapted for attachment to corresponding side walls and near a front wall and an opening of a trunk, a frame operatively mounted to the hinges such that the frame can be rotated between a deployed position and a stowed position at the front wall of the trunk, and a storage pouch supported by the frame. The Pratelli '157 application also fails to disclose or suggest the frame being expandable to increase storage space of the storage pouch, rotatable upward about the hinge such that the storage pouch opens as the frame moves away from the stowed position

toward the deployed position, and rotatable downward about the hinge such that the storage pouch bends and folds as the frame moves away from the deployed position toward the stowed position.

### **The Hynes '880 Patent**

The Hynes '880 patent discloses a holder 10 for plastic trash bags 12 including first and second generally U-shaped frame sections 20, 42, respectively. Each frame section 20, 42 has a pair of generally parallel arms 22, 44, respectively, interconnected at one pair of corresponding base ends by means of a connecting structure 4 extending and connected therebetween. The first frame section 20 includes structure 32 for support from a vertical support surface 14 with at least the opposite ends of the connecting structure 4 spaced outwardly from the support surface 14 and the other pair of free ends of the respective arms 22 projecting horizontally outwardly away from the support surface 14. The arms 44 of the second frame section 42 are resiliently urged toward slightly outwardly divergent positions and yieldable inwardly toward each other into substantially parallel positions aligned with the free ends of the respective arms 22 of the first frame section 20. The free ends of the respective arms 22, 44 of the corresponding frame sections 20, 42 include portions thereof telescopingly engaged with each other in respective sleeve sections 28, 30 and frictionally retained in relatively telescoped positions by the resiliency of the arms 44 of the second frame section 42 tending to return to their static outwardly divergent positions. When the frame sections 20, 42 are extended relative to each other, subsequent to an open end of a bag 12 being disposed thereover, the open end of the bag 12 is stretched slightly and firmly supported by the extended frame sections 20, 42 with the frame sections 20, 42 maintaining the mouth of the bag 12 in a fully open position.

However, the Hynes '880 patent fails to disclose or suggest a trunk space storage system including a pair of hinges adapted for attachment to corresponding side walls and near a front wall and an opening of a trunk, a frame operatively mounted to the hinges such that the frame can be

rotated between a deployed position and a stowed position at the front wall of the trunk, and a storage pouch supported by the frame. The Hynes '880 patent also fails to disclose or suggest the frame being expandable to increase storage space of the storage pouch, rotatable upward about the hinge such that the storage pouch opens as the frame moves away from the stowed position toward the deployed position, and rotatable downward about the hinge such that the storage pouch bends and folds as the frame moves away from the deployed position toward the stowed position.

### **The Baker '344 Patent**

The Baker '344 patent discloses a holder for use in an automobile to hold a litter bag 22 and for support on a dashboard of an automobile. The holder includes a base frame 1 open at one end and an outer frame 3 open at one end. The outer frame 3 has a configuration corresponding to that of the base frame 1 with dimensions slightly different from those of the base frame 1 to provide a close fit between the frames 1, 3 for a support of the bag 22 between them. A pair of pins 6 extend through the frames 1, 3 at respective opposite ends thereof to support the frames 1, 3 to each other. The base frame 1 is provided with scalloped portions at respective positions contiguous the corresponding pins 6. Holder means 7 is supported by the pins 6 in contiguous relationship to the base frame 1 and provided with scalloped portions at respective positions contiguous to the corresponding pins 6 and facing the scalloped portions of the base frame 1. A pair of springs 15 are disposed on the pins 6 for pressing the frames 1, 3 and the holder means 7 against one another to maintain the scalloped portions of the base frame 1 and holder means 7 in mating relationship with each other.

However, the Baker '344 patent fails to disclose or suggest a trunk space storage system including a pair of hinges adapted for attachment to corresponding side walls and near a front wall and an opening of a trunk, a frame operatively mounted to the hinges such that the frame can be

rotated between a deployed position and a stowed position at the front wall of the trunk, and a storage pouch supported by the frame. The Hynes '880 patent also fails to disclose or suggest the frame being expandable to increase storage space of the storage pouch, rotatable upward about the hinge such that the storage pouch opens as the frame moves away from the stowed position toward the deployed position, and rotatable downward about the hinge such that the storage pouch bends and folds as the frame moves away from the deployed position toward the stowed position.

### **The Flip-Up Trunk-Space-Storage System of the Present Invention**

In contrast to the related art, amended claim 1 of the present invention discloses a storage system for use within the space of a trunk, wherein the trunk defines an opening, a front wall, a rear wall, and a pair of side walls disposed between the front and rear walls. The trunk space storage system includes a pair of hinges adapted for attachment to the corresponding side walls and near the front wall and opening of the trunk. A frame is operatively mounted to the hinges such that the frame can be rotated between a deployed position and a stowed position at the front wall of the trunk. A storage pouch is supported by the frame. The frame is expandable to increase storage space of the storage pouch, rotates upward about the hinge such that the storage pouch opens as the frame moves away from the stowed position toward the deployed position, and rotates downward about the hinge such that the storage pouch bends and folds as the frame moves away from the deployed position toward the stowed position.

### **Argument**

A rejection based on § 103 must rest on a factual basis, with the facts being interpreted without a hindsight reconstruction of the invention from the prior art. Thus, in the context of an

analysis under § 103, it is not sufficient merely to identify one reference that teaches several limitations of a claim and another that teaches the other limitations of the claim to support a rejection based on obviousness. This is because obviousness is not established by combining basic disclosures of the prior art to produce the claimed invention absent a teaching or suggestion that the combination be made. Interconnect Planning Corp. v. Fiel, 774 F.2d 1132, 1143, 227 U.S.P.Q. (BNA) 543, 551 (Fed. Cir. 1985); In Re Corkhill, 771 F.2d 1496, 1501 - 02, 226 U.S.P.Q. (BNA) 1005, 1009 - 10 (Fed. Cir. 1985). The relevant analysis invokes a cornerstone principle of U.S. patent law:

That all elements of an invention may have been old (the normal situation), or some old and some new, or all new, is, however, simply irrelevant. Virtually all inventions are combinations, and virtually all are combinations of old elements. Environmental Designs v. Union Oil Co. of Cal., 713 F.2d 693, 698 (Fed. Cir. 1983) (other citations omitted).

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A patentable invention . . . may result even if the inventor has, in effect, merely combined features, old in the art, for their known purpose without producing anything beyond the results inherent in their use. American Hoist & Derek Co. v. Sowa & Sons, Inc., 220 U.S.P.Q. (BNA) 763, 771 (Fed. Cir. 1984) (emphasis in original, other citations omitted).

As a threshold matter, it is submitted that a problem cited by the present application is difficulty for elderly or disabled people to bend and reach deeply into the space of a trunk (toward the rear wall of the trunk) to retrieve items therefrom (pages 1 and 2 of the present application). The trunk-space-storage system of the present invention solves that problem by the system being attached to the side walls and near the front wall and opening of the trunk such that the system can be stowed at the front wall of the trunk (in case it is desired to have access to the entire trunk space and, thus, not to use the system). In this way, elderly or disabled people have relatively easy access to the

system and by their using the system, in turn, have relatively easy access to items stored by the system toward the front wall of the trunk.

Here, it is respectfully submitted that modifying the collapsible/foldable bag holder 10 of the Pratelli '157 application to include the second frame portion 42 and sleeve sections 28, 30 of the plastic-trash-bag holder 10 of the Hynes '880 patent does not result in the trunk-space-storage system of the type described in amended independent claim 1. Simply put, the structure and function of the present invention and its structural relationship with the corresponding elements of a trunk are much different than the structure and function of the Pratelli device and its structural relationship with the second frame portion and sleeve sections of the Hynes device.

More specifically, the Pratelli device (either alone or in combination with the second frame portion and sleeve sections of the Hynes device) cannot be attached to the side walls and near the front wall and opening of the trunk such that the frame can be stowed at the front wall of the trunk. For example, the Pratelli device (either alone or in combination with the second frame portion and sleeve sections of the Hynes device) may be attached to the front wall and near the opening of the trunk such that the frame can be stowed at the front wall of the trunk. Also, the Pratelli device may be attached to a single side wall and near the front wall and opening of the trunk such that the frame can be stowed at the side wall of the trunk. However, the structure and function of the Pratelli device, specifically those of the fixed hinge part 11 thereof, prevent the Pratelli device from being **attached to both side walls** and near the front wall and opening of the trunk such that the frame can be **stowed at the front wall** of the trunk.

Likewise, it is respectfully submitted that modifying the litter-bag holder of the Baker '344 patent to include the second frame portion 42 and sleeve sections 28, 30 of the plastic-trash-bag holder 10 of the Hynes '880 patent does not result in the trunk-space-storage system of the type

described in amended independent claim 1. Simply put, the structure and function of the trunk-space-storage system of the present invention and its structural relationship with the corresponding elements of a trunk are much different than the structure and function of the Baker device and its structural relationship with the second frame portion and sleeve sections of the Hynes device.

More specifically, the Baker device (either alone or in combination with the second frame portion and sleeve sections of the Hynes device), just like the Pratelli device, cannot be attached to the side walls and near the front wall and opening of the trunk such that the frame can be stowed at the front wall of the trunk. For example, the Baker device (either alone or in combination with the second frame portion and sleeve sections of the Hynes device), just like the Pratelli device, may be attached to the front wall and near the opening of the trunk such that the frame can be stowed at the front wall of the trunk. Also, the Baker device, just like the Pratelli device, may be attached to a single side wall and near the front wall and opening of the trunk such that the frame can be stowed at the side wall of the trunk. However, the structure and function of the Baker device, specifically those of the holder means 7 thereof, prevent the Baker device from being **attached to both side walls** and near the front wall and opening of the trunk such that the frame can be **stowed at the front wall** of the trunk.

Moreover, each of the base and outer frames 1, 3 of the Baker device is in the shape of three sides of a rectangle. As a result, in order to modify the Baker device to include the second frame portion and sleeve sections of the Hynes device, the side of each of the base and outer frames 1, 3 of the Baker device located opposite the holder means 7 would have to be eliminated.

However, the claimed combination of the Baker and Hynes devices cannot render the Baker device unsatisfactory or inoperable for its intended purpose or change its principle of operation. More specifically, if the proposed modification would render the Baker device unsatisfactory for its



intended purpose, then there is no suggestion or motivation to make the proposed modification. In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984); MPEP § 2143.01. Also, if such modification or combination would change the principle of operation of the Baker device, then the respective teachings of the Baker ‘344 and Hynes ‘880 patents are not sufficient to render amended claim 1 *prima facie* obvious. In re Ratti, 270 F.2d 810, 123 USPQ 349 (CCPA 1959); MPEP § 2143.01.

In this instance, the Baker device operates by holding three “sides” of a litter bag . . . as opposed to only two “sides.” (If the Baker device operated by holding only two “sides” of the bag, then the bag would undoubtedly substantially sag). Thus, eliminating the side of each of the base and outer frames 1, 3 of the Baker device located opposite the holder means 7 would change the principle of operation of the Baker device and render it unsatisfactory or inoperable for its intended purpose. Accordingly, there is no suggestion or motivation to make the proposed modification or combination, and the respective teachings of the Baker ‘344 and Hynes ‘880 patents are not sufficient to render amended claim 1 *prima facie* obvious.

The deficiencies in the teachings of the combination of the Pratelli ‘157 application and Hynes ‘880 patent are not overcome in the disclosure of the Baker ‘344 patent, and the deficiencies in the teachings of the combination of the Baker ‘344 and Hynes ‘880 patents are not overcome in the disclosure of the Pratelli ‘157 application. Thus, none of the references, alone or in combination with either or both of the other references, discloses or suggests the trunk-space-storage system described in amended claim 1.

The applicant respectfully submits that independent claim 1, as amended, recites structure that is not disclosed or suggested by the prior art and is patentably distinguishable from the subject matter of the references of record in this case. Claims 2, 3, and 5 are all ultimately dependent upon

claim 1 and add further perfecting limitations thereto. As such, the prior-art references, in any combination with each other or each reference standing alone, do not suggest the subject invention as defined in these claims. However, even if they did, they could only be applied through hindsight after restructuring the disclosures of the prior art in view of the applicant's invention. A combination of the prior art to derive the applicant's invention would, in and of itself, be an invention.

These amendments are necessary to overcome the respective rejections under 35 U.S.C. § 103(a) and were not earlier presented since the amendments are in response to respective new grounds of rejection. Accordingly, the applicant respectfully requests that the rejections be withdrawn.

### Conclusion

Independent claim 1, as amended, recites structure that is neither disclosed nor suggested by the prior art and is patentably distinguishable from the cited art discussed above. Claims 2, 3, and 5 are each ultimately dependent upon claim 1 and add perfecting limitations thereto. Accordingly, the applicant respectfully solicits allowance of the claims pending in the present application.

Respectfully submitted,



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